



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: William Y. Sun

Appeal No. _____

Serial No.: 10/729,973

Group Art Unit: 3739

Filed: 12/09/2003

Examiner: Flanagan, Beverly Mende

For: **TONGUE STABILIZER FOR LARYNGOSCOPE BLADE**

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APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Honorable Members of the Board of Patent Appeals and Interferences:

The jurisdiction of the Board is invoked under 35 USC 134 and 37 CFR 1.191 and 37 CFR 41.31. A Notice of Appeal is filed herewith. Both the Notice of Appeal and the Appeal Brief are timely filed.

This Appeal Brief is filed in response to the Examiner's Final Rejection dated 11/02/2005.

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i. Real Party of Interest

The real party of interest is your appellant, William Y. Sun, whose mailing address is:
205 Yoakum Parkway #623, Alexandria, VA 22405.

ii. Related Appeals and Interferences

There are no known pending applications that are related to this application.

iii. Status of Claims

Claims 1-17 are in this application.

Claims 1, 2, 4, and 6 - 9 are rejected under 35 USC 103(a) as being unpatentable over Van Dam (U.S. Patent No. 5,065,738, issued November 19, 1991) and Rooney et al (U. S. Patent No. 5,656,014, issued August 12, 1997).

Claims 3, 5 and 10 - 17 contain allowable subject matter, but are objected to as being dependent upon a rejected base claim.

iv. Status of Amendments

There are no pending amendments in this application.

v. Summary of Claimed Subject Matter

Independent claim 1 is to “a tongue stabilizer for a laryngoscope blade.” The claimed tongue stabilizer is best seen in Fig. 3 with the stabilizer shown in Fig. 4 attached to a laryngoscope blade 11. The tongue stabilizer of claim 1 has a tongue engaging plate 13 (page 4,

line 14 - page 5, line 8), a foam strip support 10, for the plate 13 (page 5, lines 9 - 17), and a pressure sensitive adhesive 12 for attachment (page 5, lines 13 - page 6 line 2).

Claim 2 depends from claim 1 and adds that the tongue engaging plate has rounded corners 3,7 best seen in Figs 1 and 2 (page 3, lines 12 - 14).

Claim 4 depends from claim 1 and adds the thickness of the tongue engaging plate as being from 0.015 to 0.125 inches (page 4, line 17 - page 5, line 2).

Claim 7 depends from claim 1 and adds the thickness of the foam strip as being from 1/32 to 1/4 inch (page 5, lines 15 - 17).

vi. Grounds of Rejection to be Reviewed on Appeal

Whether claims 1, 2, 4 and 6 - 9 are unpatentable under 35 USC 103(a) over Van Dam and Rooney et al.

vii. Arguments

For purposes of this Appeal Brief it will be assumed that the Examiner has read the claims and references. The claim rejections are clearly improper and in violation of well established patentability principles. The patents to Van Dam and Rooney et al do not even disclose a tongue stabilizer for use on a laryngoscope blade.

STRUCTURE CLAIMED

Claim Preamble

Base independent claim 1 sets forth, with emphasis added, in the preamble:

“A tongue stabilizer for a laryngoscope blade.”

Claim 1 Combination of Elements

The body of claim 1, and all other claims under consideration, with emphasis added, sets forth in pertinent part:

- a) a tongue-engaging plate . . .;
- b) a foam strip support . . .top surface attached to said tongue engaging plate bottom surface
. . . between said forward end and said rear end and between said first side and said second side;
- c) a pressure sensitive adhesive . . .extending along said foam support bottom surface.

THE STRUCTURE AND TEACHINGS OF VAN DAM AND ROONEY ET AL

Van Dam

The patent to Van Dam is irrelevant in that there is no “tongue stabilizer” disclosed. Only a laryngoscope blade per se with a padded sheath to protect teeth is disclosed by Van Dam. In use, the padded sheath is in the shape of and adhered to the surface of the laryngoscope blade.

The laryngoscope blade sheath of Van Dam provides padding on its leading edge and areas adjacent teeth during use (Abstract; Fig. 4). The invention provides a device to protect the teeth, tongue, and oral mucosa from the blade of a laryngoscope during orotracheal or direct nasotracheal intubation (column 2, lines 30-32). The sheath has two components with “an exposed surface and an adhesive surface (column 3, lines 22-23 and 30 - 40). The sheath is made of a “soft, pliable, thermoplastic foam for example polyurethane...” (column 3, lines 50 -54; column 5, lines 56 - 62). The protective padding is pliable (column 6, lines 12 - 62). The teeth protecting padded sheath can be adhered, used once, and then discarded (column 7, lines 4 - 14). As can be seen in Fig. 4, the sheath is coextensive with the shape and extent of the laryngoscope blade it is attached to.

Rooney et al

The patent to Rooney et al is irrelevant in that there is no “tongue stabilizer” disclosed. Only an illuminated tongue depressor per se with a sterile cover sheath is disclosed by Rooney et al. In use the tongue depressor 10 is totally enclosed by a transparent plastic sterile sheath 50.

The tongue depressor of Rooney et al is shown in Figs. 1 - 7 and 10. The sheath 50 for covering the tongue depressor 10 is shown in Figs. 8 and 9. The function of the Rooney et al device is expressed in the title, “Oral Examination Illuminating Tongue Depressor.” The tongue depressor 10 has a top convex surface 14 and a bottom concave surface 15 (column 2, lines 4 - 6; column 2, lines 47 - 58; Figs 1 and 3). A friction texture 65 is provided on the bottom surface 16

adjacent its end 17 (column 2, lines 7 - 22; column 3, lines 16 - 29; Figs 1 - 3, 5, 7 and 10). The top surface 14 of the blade is provided with switch 46 in recess 44, a longitudinal bore 38, for wires 40, extends from the switch 46 to the lamp 42 for conducting electricity from the battery B to the lamp 42. The longitudinal bore 38 is covered with a “relatively thin pliable plate 48.” Finger pressure on the cover plate deforms the cover plate to operate the lamp 42 switch 46 (column 3, lines 3 - 9; column 3, lines 64 - column 4, line 4; Figs. 1 - 4, 6 and 7). For sanitation the entire tongue depressor 10 is covered with a transparent plastic sterile sheath 50 during use and discarded after use (Figs 8 and 9; column 3, line 64 - column 4, line 4).

REJECTION SHORT-COMINGS

Claims 1, 2 and 8 Rejections

The Examiner has rejected claims 1, 2 and 8 based on Van Dam teaching a laryngoscope 10 having a blade 12 having a sheath 48 having pads 58 and 60 made of foam with an adhesive surface 56 having a waxed film 68 and Rooney et al having a curved forward end 16 with an abrasive texture 65 for gripping a patient's tongue. The conclusion is made that it would have been obvious to supply the exterior surface of the sheath 48 of Van Dam with a texture for gripping and holding the tongue.

1. There is no texture involved in the claims in issue.
2. The texture on Rooney et al is on the laryngoscope blade not a plate on the blade.

3. The texture on Rooney et al is covered by the sheath 48 during use.
4. The foam of Van Dam is to protect body parts from harm not to engage them.
5. The use of texture on the foam of Van Dam would be useless as the foam claimed is under the tongue-engaging plate.

Claim 1 Rejection

Claim 1, in its entirety, describes the tongue stabilizer attachment. The three primary components set forth in all of the claims are a) a tongue-engaging plate 13, b) a foam support strip 10 for the plate, and c) a pressure sensitive adhesive 12, for attaching the components to a laryngoscope blade.

Even if the sheaths of Van Dam and/or Rooney et al can be considered to be an attachment, rather than just being a covering, which they are not, neither the sheath of Van Dam nor the sheath of Rooney et al is a three component sheath. Van Dam teaches a two component sheath, a foam pad 54, 58, 60 of Fig. 4 and an adhesive attachment 66 (column 6, lines 48 - 62). The sheath 50 of Rooney et al is a single thickness plastic covering. Rooney et al use a "thin pliable plate 48" over a bore 38 and switch 46 recess 44 (column 3, lines 10 - 15). The plate 48 is in the shape of the convex surface 14; it covers and forms the upper surface of the tongue depressor. It in turn is covered by the sheath 50 during use.

a) Tongue Engaging Plate 13

A plate is provided to engage and stabilize the tongue while using a laryngoscope blade.

Van Dam and Rooney et al have no tongue engaging plate attachment. The sheath 48 of Van Dam has one function, to provide teeth or other body parts protection, using foam padding 54, 58, 60 (Abstract, Fig. 4). The sheath 50 of Rooney et al is a sterile cover.

b) Foam Strip Support 10

A foam strip support is positioned between the tongue-engaging plate and the pressure-sensitive layer. The foam strip supports the plate 13 and is deformable enough to adapt the stabilizer to different style and shape laryngoscope blades.

There is no foam disclosed by Rooney et al. The only foam disclosed by Van Dam is the foam of the sheath outer layer (column 6, lines 54 - 62). The foam is the outermost element or layer for protecting body parts (column 1, lines 5 - 14).

c) Pressure Sensitive Adhesive 12

A pressure-sensitive adhesive extends along the foam support bottom surface. The adhesive bonds the deformable foam strip to the irregular shape of a laryngoscope to support and position the tongue stabilizing plate.

While an adhesive per se is a common bonding expedient, in the combination it can hold the rigid tongue supporting plate in position on irregular shape laryngoscopes blades because it can conform to their shape in view of the foam layer it extends along the bottom side of. Neither Rooney et al nor Van Dam teach such a plate or its function in combination.

The sheath of Rooney et al is no more and no less than a cover that temporarily slips over the blade to be used once and then discarded. As disclosed in column 3, lines 33 - 61 and shown in Figs. 8 and 9, the sheath is a “sanitary sheath assembly comprising a transparent plastic sterile sheath 50 contoured and dimensioned to surround the depressor 10 from its proximal end 17 to its distal end portion 12.” The depressor is completely inserted into the sheath 50

“Following the oral examination, the user separates the sheath 50 from the depressor 10 and discards the sheath” (column 4, lines 2 - 4). The sheath of Rooney et al does not prevent tongue movement, it covers, and prevents the “abrasive texture 65, fish scale-like surface etched into the surface 17 of Rooney et al, disclosed in column 3, lines 10 - 32 and shown in Fig. 5, from functioning as intended. The sheath renders the tongue stabilizer function inoperative if it has any substantial thickness and reduces its ability to perform its function if it has any thickness at all. In any event, it provides a slippery layer between the abrasive and tongue.

The patent to Van Dam is to a laryngoscope blade sheath. The sheath is adhesively attached to the blade. It provides a padding between the blade and patient’s body parts (Abstract, Field of the Invention) “to deflect the tongue away from the lumen of the laryngoscope blade.” The blade 12 is used “to roll the tongue of a patient out of the way and allow the laryngoscopist to sight under the arc of the blade” (column 5, lines 9 - 11). The sheath is placed on the blade “to provide protection to the mouth, teeth and throat from the much harder, albeit blunt, tip” of the blade (column 6, lines 41 - 47).

Since Rooney et al do not teach providing an abrasive texture on a sheath, they cannot logically or legally be considered to teach Van Dam to place such a surface on his sheath. Further, placing an abrasive texture on the sheath of Van Dam would render his sheath inoperative for its intended purpose, i.e. deflecting and rolling the tongue away. The sheath of Van Dam exists to protect the patient's teeth, and tongue and mouth and throat from being damaged during intubation. It is designed to slip over body parts and insulate them from frictional contact with the blade. The sheath is specifically designed to be flat, planar, pliable and a soft, pliable thermo-plastic foam (column 3, lines 17, 18, 50 and 51). The blade is designed to "roll the tongue of the patient out of the way" (column 5, lines 9 - 11). To make the sheath a friction surface would be in opposition to the clear teachings of Van Dam.

Claim 2 Rejection

Claim 2 depends from claim 1 and adds that the tongue-engaging plate has rounded corners.

The claimed tongue-engaging plate must be inserted under a tongue to stabilize it and then removed from under the tongue. The tongue stabilizing plate is an addition onto a laryngoscope blade and extends beyond the blade. It is important that there be no sharp corners that would scrape the tongue or other body parts. The references do not teach a plate for extending from a laryngoscope blade for stabilizing a tongue with or without doing damage to it.

Claim 2 requires that the tongue-engaging plate forward end be rounded and that the rear end meet the sides in a rounded configuration. The rounding of the claimed plate 6 at 2 and 7 is clear. The blade end 17 of Rooney et al is flat and the rear is not rounded. The “sheath” 50 of Rooney et al has a flat end 58 and rear square corners (Fig. 8). The patent to Van Dam has a sheath that is not a plate, it is a foam padding, and while the front end may be rounded, the rear end does not have rounded rear corners.

Claim 4 Rejection

Claim 4 depends from claim 1 and adds the thickness of the tongue-engaging plate is from 0.015 to 0.125 inches. It is necessary that the tongue engaging plate be rigid enough to prevent unwanted movement of the tongue support by it.

The Examiner has rejected claim 4 as it would have been obvious to “make the texture in a thickness of 0.015 to 0.125 inches.” Since neither Rooney et al nor Van Dam teach a tongue stabilizer of any thickness, the Examiner’s opinion of the “texture” is irrelevant speculation. Claim 4 recites a plate thickness range satisfactory for supporting a tongue. It is not know what “texture” refers to.

To “texture” the blade of Van Dam to any specific depth is an examiner creation. To “texture” a plate to a depth of 0.015 to 0.125 inch, finds no support in either reference. To then cover the 0.015 to 0.125 “texture” with the 0.125 to 0.250 inch sheath of Van Dam (column 6, lines 59 - 61) would be ludicrous in the eyes of anyone in the art, being a mechanic or novice

having any common sense. The examiner is not legally at liberty to mix the sheath teachings of one patent with the blade teachings of another patent unless it is specifically disclosed within one of the references to do so. The examiner is not legally at liberty to use the teachings of one patent to accomplish the opposite results in another patent. The examiner is not legally at liberty to transpose dimensions, not found in one patent, into a second patent to accomplish a function in the second that is in opposition to the function performed in the former.

The patent to Rooney et al has no plate, only a sanitary plastic sheath or cover pulled over the blade. The plate 48 is a part of and completely covers the blade for most of its length. There is no concern for, or need for concern for, sheath thickness. Van Dam has no plate only a padding and the padding is from 0.125 to 0.25 inch. The padding needs to be 1/8 inch or more to function as padding. There is nothing in either patent to suggest any specific thickness of the claimed plate. Neither patent has a plate comparable to that claimed. There is no teaching of or reason for performing the function, by either patent, that is comparable to that of the claimed plate. The patents cannot render obvious something they do not provide for individually or collectively.

Neither Van Dam nor Rooney et al teach a tongue-engaging plate for attachment to a laryngoscope blade of any thickness.

Claim 6 Rejection

Claim 6 depends from claim 1 and adds the length of the tongue engaging plate is from 1 to

2 ½ inches long. It is necessary that the plate be large enough to support the tongue, the specific length of 1 to 2 ½ inches is a preferred range.

The Examiner has rejected claim 6 because it would be obvious to make the “texture” in a length of 1 to 2 ½ inches long. Since claim 6 addresses the tongue-engaging plate and neither Rooney et al or Van Dam teach a tongue engaging plate, the Examiner’s opinion of the “texture” is irrelevant conjecture.

The sheath of Van Dam extends all but the entire length of the blade and that of Rooney et al encompasses the entire length of the blade. There is no suggestion whatsoever in Van Dam or Rooney et al of a support plate, let alone one that extends from 1 to 2 ½ inches long. The references cannot render obvious something they do not address or even care about.

Claim 7 and 9 Rejections

Claims 7 and 9 together require the foam strip thickness to be 1/32 to 1/4 inch, and width to be 1/4 to ½ inch, and length and length to be 3/4 to 2 inches.

The Examiner has rejected claims 7 and 9 in view of Van Dam (column 6, lines 59 - 62). The cited lines read: “Preferably the sheath has a thickness approximately 0.125 inches with the padded portions being approximately 0.25 inches. The tip end being padded on both sides of the sheath would be approximately 0.5 inches.”

Claim 7 Rejection

Claim 7 depends from claim 1 and adds that the foam strip thickness is from 1/32 to 1/4 inch.

The examiner's comparison of the foam thicknesses disclosed by Van Dam and that claimed is confusing. The foam disclosed by Van Dam is to an outer element to contact body parts to prevent damage. The foam thickness claimed is to support the tongue stabilizing plate on one side and to adjust to a laryngoscope blade shape on the other. The width and length dimensions are so functionally different they cannot logically or legally be compared. Van Dam certainly does not teach or suggest the width and length of the foam strip support claimed.

It is necessary that the tongue engaging plate be firmly adhered to a laryngoscope blade. By using a small but reasonably thick foam strip the stabilizer plate can be firmly secured to a variety of size and shape laryngoscope blades. Rooney et al has no foam layer and provides no reason for providing one. Van Dam does have a foam layer but it is not between a plate and adhesive as required by claim 1. It is for padding. The plate of the claim would render the function of Van Dam inoperative and the padding of Van Dam would render the plate claimed inoperative to perform its function. The patents of Rooney et al and Van Dam do not render the claim obvious. The padding under a plate would not be padding and padding on the plate claimed would not prevent slippage.

Neither Van Dam nor Rooney et al disclose a tongue-engaging plate supported by a foam strip of any thickness.

Claim 9 Rejection

Claim 9 requires that the foam strip have a width of 1/4 to 1/2 inch and a length of from 3/4 to 2 inches.

Claim 9 depends from claim 7 and adds the width and length of the foam strip. It is necessary that the foam strip be extensive enough to firmly secure the plate to the laryngoscope blade. The specific width and length are preferred ranges.

Rooney et al have no foam strip. The foam strip of Van Dam extends the width of the blade and the length of the blade. If this were not so, the foam padding of Van Dam could not perform its padding function. To the contrary, the foam strip claimed is limited to supporting the plate and is limited in extent to support but be smaller than the plate. There is no teaching in Rooney et al or Van Dam of use of a foam strip to support a plate as claimed. Since neither reference discloses the dimension or function, they cannot render the claim obvious.

REJECTIONS CONFLICT WITH ESTABLISHED AUTHORITY GUIDELINES

In rejecting the claims, the examiner has violated each and every one of the following patentability guidelines established over many years by reviewing authorities.

1. The preamble has not been met.
2. The Examiner has failed to make out a *prima facie* case.
3. References have been combined without a teaching to do so.
4. Elements have been modified and combined without a teaching to do so.
5. Element modifications made and the resulting functions are inconsistent with the claimed invention.
6. The claim and reference wordings have not been accurately interpreted.
7. The subject matter in the claims and references does not address the same problems.
8. Elements found in the references have indiscriminately spliced together to reject the claims.
9. The claims have been rejected based on your applicant's disclosure and not the teachings of the prior art.

1. Claim Preamble

The claims are drawn to a tongue stabilizer 1 for a laryngoscope blade 11. Neither Van Dam nor Rooney et al teach an attachment to a laryngoscope blade. Rooney et al provides a sanitary disposable sheath 50 (Figs. 8 and 9, column 3, lines 34 - 43) that encloses and covers the laryngoscope blade 10. Van Dam provides a sheath 48 that has an outer padding 58, 60 to protect body parts by enclosing and covering the major outer surface of the laryngoscope blade 12 (Abstract, Fig. 4; column 6, lines 12 - 23).

Neither the reference to Van Dam nor Rooney et al meet or disclose the preamble of the claims. Neither reference teaches a tongue stabilizer for a laryngoscope blade. A sheath that

takes the shape of a laryngoscope blade as it covers it is not a tongue stabilizer. Any stabilization of tongues by the devices of Rooney et al and Van Dam must be provided by the laryngoscope blade that their sheaths cover.

As here, when a preamble is essential to understanding the claim itself, the relevant prior art is limited. Freund Industrial Co. V. Driam Metall Product GmbH Co., 12 USPQ 2d 1641 (DCSNY 1989).

While the preamble is not normally considered part of the claim, it is deemed part of the claims where necessary to breath “life and meaning” into the claims. Corning Glass Works v. Sumitomo Electric USA, 9 USPQ 2d 1962 (Fed Cir 1989). The purpose set forth in the preamble is more than a mere statement of purpose, it is essential to particularly point out the invention defined by the claims. The limitations appearing in the preamble are necessary to give meaning to the claims and properly define the invention. In re Bullock, 203 USPQ 17 (CCPA 1979); Computervision Corp., 221 USPQ 669 (Fed Cir) cert. Denied, 469 U.S. 857 (1984).

As stated by the Federal Circuit: a court charged with claim construction must construe the preamble and the remainder of the claim as one unified and internally consistent recitation of the claimed invention, when the preamble is not merely a statement describing the invention’s intended field of use but instead is intimately meshed with the ensuing language in the claim. The first appearance of terms in the claim body in this case could only be understood or

discerned in the context of the preamble's use of those terms. Pitney Bowes v. Hewlett Packard, 51 USPQ 2d 1161 (CAFC 1999).

2. No *Prima Facie* Obviousness

The Examiner has failed to make out a *prima facie* case of obviousness. Placing the roughened surface 65 of Rooney et al on the foam surface 62 of Van Dam does not result in a tongue stabilizing plate or a tongue stabilizing plate over a foam support. It results in a rough foam pressing or grasping against teeth or other body parts the foam is intended to protect. Both Van Dam and Rooney et al teach placing a cover over the blade rather than attaching something to a blade.

If the cited prior art teaches away from the claimed invention then it cannot support a *prima facie* obviousness rejection. U.S. v. Adams, 148 USPQ 479 (USSC 1966).

When the prior art is simply incapable of functioning as required by the present claims and achieving what is achieved by the present claims, the Examiner has failed to make out a *prima facie* case. Ex parte Gould, 231 USPQ 943 (BdApp 1986); In re Reinehart 189 USPQ 143 (CCPA 1976).

The mere fact that the prior art can be modified does not make the modification obvious or establish *prima facie* obviousness unless the prior art suggests the desirability of the modification. In re Gordon, 221 USPQ 1125 (CAFC 1984).

3. No Teaching to Combined References

Before two references can be combined, there must be a teaching within the four corners of the references that teaches making the combination.

The Court of Appeals for the Federal Circuit stated that combining separate teachings in prior art references to establish a case for obviousness must be based on a suggestion or motivation therefor in the prior art. W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed.Cir. 1983). References may not be combined indiscriminately and it must be determined whether the prior art suggests doing what Applicant is doing. In re Shaffer, 108 USPQ 326 (CCPA 1956). A combination of references which requires a change in the basic principle under which the basic reference was designed to operate is improper. In re Ratti, 123 USPQ 349 (CCPA 1959). The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick, 221 USPQ 481 (FedCir 1984).

A combination of prior art references requires consideration of whether the prior art would have suggested to those of ordinary skill in art that they should make claimed composition or device, or carry out claimed process, and whether prior art would also have revealed that such person would have reasonable expectation of success; both suggestion and reasonable expectation of success must be founded in prior art, not in applicant's disclosure. In re Vaeck, 20 USPQ2d, 1438 (CAFC 1991).

The Federal Circuit has emphatically stated that a suggestion, teaching, or motivation to combine prior art references is an essential component of an obviousness holding. This need for specificity pervades precedential authority and that teachings of references can be combined only if there is some suggestion or incentive to do so. In re Sang-Su Lee, No. 00 - 1158 (Fed.Cir. Jan. 18, 2002).

4. No Teaching to Combined Prior Art Components

Combining references' components or elements requires direction to do so. The examiner has combined reference components when there is no teaching within the four corners of the references to make the component combination or substitution. There are few concepts in patent claim interpretation that are as well established as that required to combine references' components to show that a claim combination is obvious. There are no teachings in either *Van Dam* or *Rooney et al* suggesting combining elements that would render the claims obvious.

An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. Ex parte Levengood, 28 USPQ 2d 1300 (BdApp 1993). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under §103, "the teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929 (CAFC 1984).

The claim requirements cannot simply be ignored. The applied references do not teach or support the materials, elements nor the coupling of the elements. Ehrreich et al 200 USPQ 504 (CCPA 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In re Geiger, 2 USPQ 2d 1276 (CAFC 1987); In re Fine 5 USPQ 2d 1596 (CAFC 1988).

Where nothing in the prior art suggests to one of ordinary skill in the art the desirability of combining the features shown in the different references, the claims should be held to be allowable. In re Osweiler, 145 USPQ 691 (CCPA 1965).

5. Indiscriminate Modifications of Prior Art Components

Modifications made must be consistent with both the disclosed use and claimed use. Neither Van Dam or Rooney et al address tongue stabilization or a tongue stabilizer on a laryngoscope blade.

Patents are references only for what they clearly disclose or suggest. It is not proper use of a reference to modify its structure to one which prior art references do not teach. In re Randal et al, 165 USPQ 586 (CCPA 1979); Milliken Research v. Beaunit, 182 USPQ 421 (DCWDMC 1974).

A reference that leads one of ordinary skill in the art away from the claimed invention cannot render it obvious. The references do not teach the claimed invention, they, if even considered by the mechanic in the art, would lead the mechanic away from the invention. A reference that leads one of ordinary skill in the art away from the claimed invention cannot render it obvious. Dow Chemical Co. V. American Cyanamide, 2 USPQ 2d 1350 (CAFC 1987).

When all the disclosures in a reference are considered, the overall suggestion to emerge from the prior art reference may be contrary to that which might appear from isolated portions of the reference. In re Hughes, 193 USPQ 141 (CCPA 1977).

A modification of the prior art references which is not taught by the references cannot be relied on under 35 USC 102 or 35 USC 103. Deering Milliken Research Corp. V. Beaunit Corp., 182 USPQ 421 (DCWNC 1974).

6. Elements and Wording Interpretations Must be Accurate for Comparability

The Examiner's rejection of the claim combinations implying that by roughness of the foam of Van Dam it becomes a plate or functions as a plate is ridiculous as are the foam and sheath interpretations.

All words of a claim must be considered in judging the patentability of a claim against the prior art. In re Miller, 169 USPQ 597 (CCPA 1971). A term in a claim is to be given a construction consistent with the ordinary and customary meaning of the term and the intrinsic

evidence from the patent itself. Hill-Rom v. Kinetic Concepts & KCI Therapeutic Servs., 54 USPQ 2d 1437 (CAFC 2000); Cortland Line v. Orvis, 53 USPQ 2d 1734 (CAFC 2000).

The requirements of a claim cannot simply be ignored. In re Ehhreich et al, 200 USPQ 504 (CCPA 1979) and must be considered material absent external evidence suggesting otherwise. Ontario Die of America v. Independent Die, 18 USPQ 2d 1477 (DCE Mich 1990); In re Boe, 184 USPQ 38 (CCPA 1974); Ex parte Murphy & Burford, 217 USPQ 479 (BdApp 1982).

The Examiner having assigned attributes to the references which do not in fact exist and entirely discounting the critical language within the claims does not comply with the Graham requirement of objectively identifying the differences between the claimed invention and the prior art. Graham v. John Deere, 148 USPQ 459 (USSC 1966); In re Wood and Everrole, 202 USPQ 12 (CCPA 1979).

7. Claim and Reference Problems Addressed Must be the Same

The invention is to a tongue stabilizer. The patent to Van Dam is to a body protecting foam sheath for a laryngoscope. The patent to Rooney et al is to a sterile sheath for covering a laryngoscope blade. The parts of the devices perform entirely different functions from that claimed.

Where neither reference is directed to the problem solved by an applicant and only applicant's specification suggests any reason for combining the teachings of the prior art, it is improper to select statements from the references and combine them with other references to arrive at applicant's claimed combination. In re Pye and Peterson, 148 USPQ 426 (CCPA 1966); In re Stephens et al 145 USPQ 656 (CCPA 1965).

For the teachings of a reference to be prior art under 35 USC 103, there must be some basis for concluding the reference would have been considered by one skilled in the particular art working on the pertinent problem to which the invention pertains. For no matter what a reference teaches, it could not have rendered obvious anything, "at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains," unless said hypothetical person would have considered it. In re Horn, Horn, and Horn, 203 USPQ 969 (CCPA 1979).

The prior art must address and provide the inventor's answer to the particular problem confronting an inventor. In re Winslow, 151 USPQ 48 (CCPA 1966). The relationship between the problem the inventor was attempting to solve and the problem to which any prior art reference is directed is highly relevant. Stanley Works v. McKinney Mfg. Co, 216 USPQ 298 (Del DC 1981); In re Luvisi and Nohejl, 144 USPQ 646 (CCPA 1965). To show obviousness, the structure of the references must function in essentially the same way to produce substantially the same result. Pennwalt Corp. V. Durance Wayland, Inc., 4 USPQ 2d 1737 (CAFC 1987).

8. Prior Art Components Have Been Arbitrarily and Randomly Spliced Together

The Examiner has taken bits and pieces from the references, Van Dam and Rooney et al, and spliced them together in an attempt to reject the structure claimed. It is not permissible to reconstruct prior art devices to something they are not to reject a claim.

It is not permissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Hedges et al, 228 USPQ 685 (CAFC 1986); In re Wesslau, 147 USPQ 391 (CCPA 1956).

The rejection can only be based on the fragmenting and reconstruction of the prior art. It is improper to arrive at a conclusion of “obviousness” by fragmenting the invention into small elements and then proceeding to focus on individual features rather than by viewing the invention in its entirety. Blonder-Tongue Laboratories v. University of Illinois Foundation, 402 U.S. 313 (USSC 1971).

In connection with combining features of different patents, the Examiner’s attention is directed to the opinion Ex Parte Fleischmann, 157 USPQ 155 (BdApp 1967) which states:

“While as an abstract proposition it might be possible to select features from the secondary references, as the Examiner has done, and mechanically combine them with the Mallin device to arrive at appellant’s claimed combination, we find absolutely no

basis for making such combination neither disclosed nor suggested in the patents relied upon. In our view only appellant's specification suggests secondary references with the primary reference and under the provisions of 35 USC 103 that does not constitute a bar."

9. Obvious Improper Hindsight Rejections

The present rejections are a classic example of hindsight rejections. The modifications proposed to the Rooney et al and Van Dam patents can only be based on hindsight as there certainly is no teaching within the patents to make the modifications proposed by the Examiner. Only the present disclosure and claims suggest the modification and reconstructions made to and within Van Dam and Rooney et al. It would be difficult to find a better example of a hindsight reconstruction rejection than that of the present Examiner's rejection.

It is not permissible to ascertain factually what was done and then view the prior art in such a manner as to select from random facts which may be modified and utilized to reconstruct the invention. Application of Shumann, 316 F2d 100 (CCPA 1966).

More than an opinion or speculation and hindsight are required to reach a legal conclusion of obviousness. In re Sporck, 133 USPQ 360 (CCPA 1962). A combination rejection must be supported by something other than applicant's own disclosure. In re Shaffer, 108 USPQ 326 (CCPA 1956). To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record suggest that knowledge is hindsight where that

which only the inventor taught is used against its teacher. W.L. Gore & Associates v. Gorlock Inc., 220 USPQ 303 (CAFC 1983); In re Harry Spinnoble, 160 USPQ 237 (CCPA 1969).

The use of appellant's disclosure in reconstruction of references to meet claims is barred since, under 35 USC 103, obviousness must be tested at the time the invention was made; and, claims are allowable when the only source which would leave a person of ordinary skill to make the last step in reconstruction is appellant's disclosure, In re Pavlecka, 138 USPQ 152 (CCPA 1963).

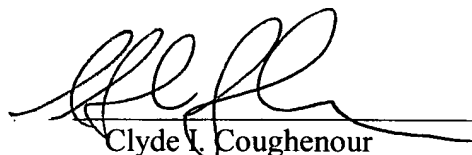
The Federal Circuit repeated its prohibition against "hindsight" in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ 2d 1434, (Fed. Cir. 1988), where it was held (with emphasis added):

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

CONCLUSION

Claims 1, 2, 4 and 6 - 9 are patentable over Van Dam and Rooney et al and are in condition for allowance. The decision of the Examiner finally rejecting claims 1, 2, 4 and 6 - 9 should be reversed. Such action is earnestly solicited.

Respectfully submitted



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Claims Appealed

1. A tongue stabilizer for a laryngoscope blade comprising:

a tongue-engaging plate having a top surface, a bottom surface, a forward end, a rear end, a first side, a second side and a central area;

a foam strip support having a top surface and a bottom surface with said foam top surface attached to said tongue engaging plate bottom surface between said forward end and said rear end and between said first side and said second side;

a pressure-sensitive adhesive having a top surface, attached to and extending along said foam support bottom surface, and a bottom surface, available for attaching said tongue stabilizer to a laryngoscope blade.

2. A tongue stabilizer for a laryngoscope blade as in claim 1 wherein:

said tongue-engaging plate forward end is rounded and said rear end and said first side meet in a rounded corner and said rear end and said second side meet in a rounded corner.

4. A tongue stabilizer for a laryngoscope blade as in claim 1 wherein:

said tongue-engaging plate has a thickness of from 0.015 to 0.125 inch.

6. A tongue stabilizer for a laryngoscope blade as in claim 1 wherein:

said tongue-engaging plate length between said forward end and said rear end is from 1 to 2 ½ inches long.

7. A tongue stabilizer for a laryngoscope blade as in claim 1 wherein:

said foam strip has a thickness of from 1/32 to 1/4 inch.

8. A tongue stabilizer for a laryngoscope blade as in claim 1 wherein:

a protective covering on said pressure-sensitive adhesive bottom surface to protect it from contamination.

9. A tongue stabilizer for a laryngoscope blade as in claim 7 wherein:

said foam strip has a width from 1/4 to ½ inch and a length of from 3/4 to 2 inches.

ix.

EVIDENCE APPENDIX

Evidence Relied On

The patents relied on by the Examiner are Van Dam (U.S. Patent No. 5,065,738, issued November 19, 1991) and Rooney et al (U.S. Patent No. 5,656,014, issued August 12, 1997).